REMARKS

Revocation & Power of Attorney / Change of Address

Counsel responsible for prosecution of the present application has changed. As such, the correspondence address for this application has also changed. A *Request for Withdrawal as Attorney or Agent and Change of Correspondence Address* was submitted by ***prior*** counsel and received by the U.S. Patent Office on March 9, 2006. That *Request* reflected that the new correspondence address for this application is **2200 Geng Road, Palo Alto, CA 94303**. Notwithstanding, the present action was mailed to *prior* counsel's address on March 16, 2006.

Present counsel submitted a *Revocation & Power of Attorney* and *Statement Under 37 C.F.R. § 3.73(b)* on March 16, 2006. As of the date of this response, the Patent Office's Patent Application Information Retrieval (PAIR) system reflects that *prior* counsel's address remains of record. PAIR further reflects that ***prior*** counsel remains attorney of record.

The Examiner is respectfully requested to assist in ensuring that the ***prior*** power of attorney is ***revoked;*** the ***new*** power of attorney ***instituted;*** and the ***correspondence address*** for this application be ***changed to***:

Customer Number 22830

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Applicants' counsel has submitted, herewith, a *Change of Correspondence Address* (PTO-SB-122) to assist in this regard. Applicants' counsel looks forward to working with the Examiner in the present application with regard to bringing prosecution to a mutually agreeable conclusion.

Information Disclosure Statement

Applicants have submitted, herewith, an *Information Disclosure Statement*. The Examiner is respectfully requested to consider the same.

Rejection Under 35 U.S.C. § 103(a)

The Examiner has rejected claims 2-6, 9, 22-27, 30, 43-48, 51, and 64-66 "under 35 U.S.C. 103(a) as being unpatentable over Matsumo (6,409,604) in view of Iwao et al. (U.S. Patent Number 6,533,663)." *Office Action*, 2. This rejection covers all of the independent claims presently pending in the application. The Applicants respectfully traverse the Examiner's rejection in that Iwao et al. is not a reference on which a rejection can be made.

The present application was filed on **January 31, 2001**. The Iwao et al. reference, while claiming the priority benefit of Japanese patent application 11-209855 filed on July 23, 1999, was not filed ***in the United States*** until May 30, 2000. A relevant portion of the face of Iwao et al. and reflecting this filing information is reproduced below.

(54) **METHOD OF ASSISTING SELECTION OF ACTION AND PROGRAM PRODUCT AND GAME SYSTEM USING SAME**

(75) Inventors: **Kenichi Iwao**, Tokyo (JP); **Yukio Ando**, Osaka (JP); **Kenro Tsujimoto**, Osaka (JP)

(73) Assignee: **Square Co., Ltd.**, Tokyo (JP)

(*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 0 days.

(21) Appl. No.: **09/580,570**

(22) Filed: **May 30, 2000**

(30) **Foreign Application Priority Data**

Jul. 23, 1999 (JP) 11-209855

For Iwao et al. to be utilized under 35 U.S.C. § 103(a), it must otherwise qualify as a valid reference under 35 U.S.C. § 102. Iwao et al. does not qualify as a 35 U.S.C. § 102(a) reference in that there is no evidence that any purported invention disclosed in Iwao et al. was known or used by others in the U.S. or described in a printed publication in this or a foreign country before the invention thereof by the present Applicants.

Iwao et al. does not qualify as a 35 U.S.C. § 102(b) reference in that Iwao et al. did not publish in the United States until **March 18, 2003.** This date is more than two years after the filing date of the present application, which occurred on **January 31, 2001.**

The only remaining provision under which Iwao et al. could be a valid reference for use in a rejection is under 35 U.S.C. § 102(e)(2). 35 U.S.C. § 102(e)(2) provides "[a] person shall be entitled to a patent unless: the invention was described in . . . a patent granted on an application for patent ***by another filed in the United States before the invention by the applicant for patent***" (emphasis added). Iwao et al. was **not**, however, filed **in the United States** prior to the invention of the presently claimed subject matter by the Applicants.

The Applicants have submitted herewith a declaration pursuant to 37 C.F.R. § 1.131 that evidences the **conception** and **reduction to practice** of the invention presently claimed in the present application. Specifically, the Applicants contend that the presently claimed invention was **conceived** by at least **May 2, 2000** and **actually reduced to practice** no later than **June 27, 2002** with **constructive reduction to practice** through filing of the present application occurring **January 31, 2001**. Iwao et al. was not filed in the United States until **May 30, 2000**—*after* the conception/invention of the subject matter of the present application by the Applicants, which occurred at least by May 2, 2000.

The Rule 131 declaration and attached exhibit submitted herewith provides a clear explanation pointing out the facts that are relied upon to evidence invention by the Applicants prior to the United States filing of the Iwao et al. reference. See *In re Borkowski*, 505 F.2d 713, 718-19 (CCPA 1974); see also MPEP § 715.07(I). The Rule 131 declaration, in the process of asserting those facts, further identifies what they are and when they occurred. See *In re Harry*, 333 F.3d 920 (CCPA 1964). The Rule 131 declaration further satisfies the requirement of 37 C.F.R. § 1.131(b) in that the aforementioned facts evidence (1) conception of the invention (at least May 2, 2000) prior to the effective date of the reference (May 30, 2000) and (2) due diligence from prior to the reference date to a subsequent reduction to practice both constructively (through the January 31, 2001 filing of the present application) and actually (at least through a commercial product release on June 27, 2002).

Acceptance of the present declaration is necessary in that it disqualifies the Iwao et al. reference, which is not a proper prior art reference. To cause the Applicants to comment on the Iwao et al. reference or to further amend the claims of the present application in light of Iwao et al. (as would be necessary if the present Rule 131 declaration is refused) would be to adversely affect the scope of patentable subject matter to which the Applicants might otherwise be entitled.

CONCLUSION

In that the Applicants have evidenced the **invention** of the presently claimed application ***prior to*** the **filing** of the Iwao et al. reference **in the United States**, the Applicants respectfully submit that the Iwao et al. reference is not a valid reference for use in a rejection under 35 U.S.C. § 103. As each and every rejection recited by the Examiner in the present application relies, in part, on the Iwao et al. reference, each and every rejection is overcome through disqualification of that reference.

The declaration showing prior invention is, in and of itself, appropriate in that evidence of conception was not previously known prior to the present submission. The submission is further appropriate in that refusal to accept the declaration would be to force the Applicants to distinguish or amendment the present claims in light of art that is not valid prior art as defined by the United States patent laws.

The Examiner is invited to contact the Applicant's undersigned representative with any questions concerning the present response or any other aspect of the present application.

Respectfully submitted,
Timothy Neveu et al.

June 12, 2006

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